

REMARKS

Claims 1-82 and 87-104 have been cancelled in their entirety, without prejudice, for reasons set forth below. Claim 83 has been rewritten into independent format and new claims 105-137 have been added for reasons set forth below. New matter is not introduced by this amendment. Specifically, support in both U.S. Patent No. 6,333,699 and in the captioned application (which is a continuation thereof) for each of the claims remaining in the captioned application, i.e. claims 83-86 and 105-137, is set forth in attached Claim Charts A and B, respectively. In each attached claim chart, the claims have been artificially divided out into segments, merely for the convenience of the Examiner. As such, these claim segments do not necessarily constitute distinct claim elements. Further, the citations next to each claim segment in each claim chart of column and line or page and line where support is found in the captioned application or U.S. Patent No. 6,333,699 is not to be construed that support is not found elsewhere in these documents but only that support exists at least at these citations.

Accompanying this amendment is a Request for Interference between the captioned application and U. S. Patent No. 6,333,700 B1. U.S. Patent No. 6,333,700 B1 issued December 25, 2001 on an application filed March 28, 2000, names Hubertus V. Thomeer and Sarmad Adam as inventors, and is assigned on its face to Schlumberger Technology Corporation. Previously, claims 1-6, 10-14, 18-23, 30-34, 37-42 and 48 were copied from U. S. Patent No. 6,333,700 B1 and presented as claims 76-104, respectively, in the captioned application by preliminary amendment dated December 20, 2002. For reasons set forth below, claims 1-6, 10, 18-23, 30-34, 37-42 are not patentable to Schlumberger over teachings of any of U.S. Patent Nos. 6,434,649 B1, 6,359,569 B2, 6,481,505 B2 or 6,497,280 B2. As the latter three patents are all divisionals of U.S. Patent No. 6,434,649 B1 (the "649 patent"), all references below to the specification of '649 patent shall be equally applicable to corresponding sections of the specification in the latter three patents. Specifically, claims 1, 3-6, 10, 18-23, 30, 32-34 and 38 of U.S. Patent No. 6,333,700 B1 are unpatentable over the disclosure in column 2, lines 7-54, column 4, line 40 – column 5, line 61, column 6, line

55 – column 7, line 11, column 7, line 43 – column 8, line 4, and Figs. 1, 3, 6 and 8 of the '649 Patent. In addition, claims 2 and 31 of U.S. Patent No. 6,333,700 B1 are unpatentable over the disclosure in column 10, line 52 – column 11, line 37 and column 14, lines 12-18 of the '649 patent. As interference proceedings are only concluded between patentable claims, claims 76-82 and 87-104 (i.e., claims 1-6, 10, 18-23, 30-34, 37-42 of the '700 patent to Schlumberger) have been cancelled in their entirety, without prejudice, by this amendment so as to simplify the issues on interference.

Claims 11-14 of U.S. Patent No. 6,333,700 B1 are being retained in the captioned application as claims 83-86. Accordingly, claim 83 has been rewritten into independent format including all of the limitations from now cancelled independent claim 76 from which it depended. These claims are patentable over any of U.S. Patent Nos. 6,434,649 B1, 6,359,569 B2, 6,481,505 B2 or 6,497,280 B2 since locating tubular members at different depths in a wellbore and using the determined identification code to determine the depth of the second downhole structure in the wellbore as set forth in claims 83-86 is not taught by any of U.S. Patent Nos. 6,434,649 B1, 6,359,569 B2, 6,481,505 B2 or 6,497,280 B2 which are prior art to U.S. Patent No. 6,333,700 B1 from which claims 83-86 are copied from.

For purposes of focusing the interference on the specific patentable invention that is claimed in U.S. Patent No. 6,333,700 B1 and is disclosed in the captioned application, the claims have been redrafted and presented as new claims 105-137 to focus the remaining claims on the overlapping subject matter so as to simplify the issues for interference. This overlapping subject matter encompasses a method of transporting a tool and a reader assembly through a well and controlling the operation of the tool responsive to the reader assembly locating a radio identification device which is at a depth in the well appropriate for conducting the operation of the tool. Use of well depth garnered from reading radio identification devices in a well to control an operation of a tool transported through a well is to be distinguished from use of geologic depth. Claims 19-51 pertain to ascertaining depth of a radio identification device using a well log. These claims were previously cancelled by the Preliminary Amendment

a well log. These claims were previously cancelled by the Preliminary Amendment dated December 20, 2002 and presented in a separate U.S. patent application serial no. 10/323,536 filed on December 18, 2002 which is patentably distinct from the invention currently claimed herein.

A review of the claims issued in the parent application, U.S. Patent No. 6,333,699, identified claims 25 and 29 which encompass operation of a tool in response to determination of depth in a well using a radio frequency receiver on the tool in conjunction with radio identification devices in the line or well through which the tool is being transmitted. In light of this overlap in the claims, a Terminal Disclaimer is being filed concurrently herewith with respect to any patent that may issue from the captioned application.

Applicants' attorney wishes to thank the Examiner for the courtesy extended during a personal interview conducted on August 27, 2003. Also in attendance on behalf of Applicants at this interview was Elizabeth C. Weimar, Esq. During that interview, the common subject matter between the captioned application and U.S. Patent No. 6,333,700 was discussed as well as the unpatentability of numerous claims previously copied from the '700 patent. The general character of proposed amendments to focus the claims on the specific conflicting subject matter between the captioned application and the '700 patent was also discussed.

Should any fees be necessary to process this Preliminary Amendment or the accompanying Request for Interference or Terminal Disclaimer, the Commissioner is hereby authorized to charge any fees to Deposit Account No. 13-1505.

Applicant respectfully requests entry and consideration of the accompanying request for interference in light of this amendment.

Respectfully submitted,

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